

REMARKS

In response to the Office Action dated December 10, 2008, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks.

Applicant appreciates the Examiner's comprehensive examination of the application. Applicant also appreciates the Examiner's provision of responses to Applicant's arguments to advance prosecution of the present application.

Status of the Claims

Claims 16, 24-28, 44, 52-56, 72 and 80-84 stand rejected under Section 112. Claims 1-2, 4, 6-15, 19-23, 29-30, 32, 34-43, 47-51, 57-58, 60, 62-71, 75-79 and 85 stand rejected under Section 103(a) as being unpatentable over U.S. Patent No. 6,374,241 to Lamburt (Lamburt) in view of Items U1-X7 cited in the PTO-892 (collectively referred to herein as "Superpages"). Claims 29-30, 32, 34-44 and 47-56 stand rejected under Section 103(a). Claims 57-58, 60, 62-72, and 75084 stand rejected under Section 103(a).

The Rejections under Section 103

Applicant again hereby incorporates by reference Applicant's arguments as set forth in Applicant's Responses dated October 19, 2007 and September 9, 2008. Applicant respectfully submits that those arguments apply to the current rejections as well. In particular, the ordinarily skilled artisan would not understand Lamburt to disclose or teach permitting a customer to configure a particular, unique, individualized, customized business listing and receiving an order request from the customer via the Web site to place an order for the customized business listing in the business directory as claimed. As best understood and discussed in the prior Responses, the Superpages reference itself teaches a method for enabling placement of an order in the context of Lamburt that requires interfacing with a sales representative. Traditionally, listing enhancements have been offered to customers through direct interactions or negotiations with sales representatives of the business directory offeror. Thus, the ordinarily skilled artisan in view of Lamburt, particularly in further view of Superpages, would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative.

In response to the foregoing arguments, the Action states at pages 3-4:

In response to applicant's argument that "the ordinarily skilled artisan in view of Lamburt would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative." It is noted with regard to this application and this argument that if such an expectation is present within the art then it would also apply to the present application. If such an implication is automatic, as argued by the applicant, then there is nothing indicating that the present invention does not do the same. Recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues that the recitations are actual steps, not recitations of intended use. In addressing the prior art however, applicant argues that the disclosure of the same steps would be understood by a person of ordinary skill to imply that a human contact is necessary. Applicant then argues that in the present application they should not be so interpreted. Thus the argument asserts that applicant's intention should be the determinative factor rather than a straight comparison of the claims with the prior art. Whether it is called intended use or not, the claims must stand on their own as distinguishable from the prior art when given their broadest reasonable interpretation. There is no room for conveniently implying different intentions. The claims must be clearly distinguishable on their face. Applicant, referring to the expectation of human participation in the method, argues that the present claims "explicitly recite steps or elements contrary to said expectations." Examiner does not agree. If the applicant's argued intent were explicit from the claims there would be no need to base the arguments on intent.

Examiner here notes that, even were applicant's argument accepted and one were considered manual while the other automatic, it has been held that providing an automatic means to replace the manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully suggests that the Action may be confusing, on the one hand, Applicant's statements characterizing the inventions as claimed and, on the other hand, Applicant's arguments as to what the cited art would reasonably suggest to the ordinarily skilled artisan. Applicant readily acknowledges that claim recitations presented in a manner that only describes intended use may not be attributed patentable weight. That is not the case

here. In the present case, the noted differences between the claimed methods, systems and computer products and the methods, systems, and computer program products of Lamburt (as properly modified in view of Superpages) cannot be properly regarded as merely “intended use.” Applicant does not argue, in addressing the prior art, that “the disclosure of the same steps would be understood by a person of ordinary skill to imply that a human contact is necessary” (Action, page 3). To the contrary, Applicant points out that the same steps (*i.e.*, the claimed steps) are not in fact disclosed in the cited art. Applicant does not assert the Applicant’s intent should be the “determinative factor” in construing the claims, but rather that all recited limitations of the claims should be considered.

Turning to the recitations at issue in more detail, Claim 1 explicitly recites, *inter alia*, a step of:

receiving an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

Similarly, Claim 29 explicitly recites, *inter alia*:

means for receiving an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

Similarly, Claim 57 explicitly recites, *inter alia*:

computer readable program code configured to receive an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

In order to advance prosecution, Applicant has amended Claim 1 to further explicitly recite a step of:

soliciting at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer; and

Similarly, Claim 29 has been amended to further recite:

means for soliciting at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer; and

Similarly, Claim 57 has been amended to further recite:

computer readable program code configured to solicit at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer; and

The foregoing recitations are recitations of actual steps, structures or computer readable program code that form parts of the claimed inventions, not merely recitations of intended use. The underlined passages are plainly and positively stated and not reasonably subject to treatment as statements of mere intended use. These steps, structures and computer readable program code are indeed contrary to the aforementioned expectation in the art, but that by no means provides grounds for ignoring them or reading them out of the claims. Applicant does not rely on "intent" in construing the proper scope of Applicant's claims. Rather, Applicant recites concrete steps, means and computer readable program code. The broadest reasonable interpretation of the claims does not permit a reading that reads on Lamburt.

Having established the concretely recited steps and components of Applicant's claimed inventions, Applicant now turns to the cited art. Lamburt simply fails to itself teach or suggest either the step of (or corresponding means or computer readable program code):

receiving an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

or the further step of (or corresponding means or computer readable program code):

soliciting at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business

listing in the business directory, including the first and second optional listing enhancements requested by the customer;

Therefore, in order to support the rejection as presented, Lamburt must inherently or implicitly include the missing steps. But Lamburt does not. Regarding the method of Claim 1, Lamburt would not solicit placement of an order via the Web site as claimed and a customer of Lamburt would not place an order request via the Web site as claimed, because the Lamburt system as configured ostensibly is not configured to solicit, process and receive such an offer. Similarly, the Lamburt system would not include means for soliciting an order or means for receiving an order request or computer readable program code configured to solicit or receive an order request as claimed. Restated, Lamburt is not capable of performing the steps of Claims 1, 29 and 57.

Nor would the ordinarily skilled artisan infer the missing steps from Lamburt or regard the missing steps as obvious modifications to the Lamburt method. To the contrary, as discussed above, the ordinarily skilled artisan in view of Lamburt and Superpages would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative.

In view of the foregoing, Applicant submits that the explicit limitations of Claims 1, 29 and 57 cannot properly be disregarded as intended use. In summary, the expectation in the art necessarily applies to the determination of the effective scope of the disclosure of Lamburt, but does not apply to Applicant's claimed inventions inasmuch as Applicant's claims plainly distinguish the claimed inventions from the traditional practice. As previously discussed, neither Lamburt nor Superpages suggests a method, system or computer program product as claimed.

Regarding the Action's final argument, the difference between the claimed inventions and the Lamburt method and system is not merely a matter of automatic versus manual. Rather, the claimed method can provide an altogether different channel of communication, mode of operation and process for soliciting and receiving an order as described.

In view of the foregoing, Applicant respectfully submits that Claims 1, 29 and 57 are allowable over the cited art. Claims 2, 4, 6-16, 19-28, and 85 depend from Claim 1, Claims

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30, 32, 34-44, and 47-56 depend from Claim 29, and Claims 58, 60, 62-72, and 75-84 depend from Claim 57, respectively, and these claims are therefore allowable as well for at least these reasons.

CONCLUSION

Applicant respectfully submits that this application is now in condition for allowance, which action is requested. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

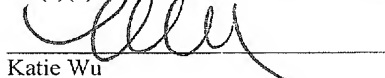


David D. Beatty
Registration No. 38,071
Attorney for Applicant

USPTO Customer No. 39072
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

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Katie Wu